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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------|------------------------|
| 10/620,549 | 07/16/2003 | Peter Seitz | 13027.43US01 | 8444 |
| 23552 | 7590 | 06/18/2007 | | |
| MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903 | | | EXAMINER DICUS, TAMRA | |
| | | | ART UNIT 1774 | PAPER NUMBER |
| | | | MAIL DATE 06/18/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/620,549 | Applicant(s) SEITZ, PETER | |
| | Examiner Tamra L. Dicus | Art Unit 1774 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The cancellation of claims 3, and 8-12 are acknowledged.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the pants and person sitting down on an object and a pattern on an item to be worn must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner believes that independent claim 13 (new) and independent claims 14-16 (new) do not have the proper support in the original specification as filed because the specification does not provide any teaching on obtaining pressure distribution patterns from when a person sits down, how samplings, mean and peak values are obtained, or how pants are identified, or its usage with Applicant's claimed identification device. The claims refer to a pressure-distribution pattern and a two-dimensional sampling. However, neither term is described with enough detail to show or explain how the application of the identification device or the device itself is produced, specifically no sufficient description exists on how patterns are formed or images obtained by taking mean and peak and plurality of samplings or values during sitting or what the "special method" is that generates the two-pressure distribution patterns shown in Fig. 1 and 2 (see Applicant's specification at page 5, line 24-31) or how "different high pressures are represented by area elements that are shaded in different ways or colors". For

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instance, there are no calculations or equations detailed within the instant specification. It is not clear from the specification how pattern-distributions are taken while one is actively sits down on a solid object. See for example, instant specification at page 4, [0012], lines 20-25. The instant specification does not describe how the pressures are obtained to yield the pattern via colors and shades. For example, see Applicant's specification at page 3, line 10-33, and page 5, line 26.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,454,600 to Floyd in view of USPN 5,885,229 to Yamato et al.

Floyd teaches an infinite array of images may be contained in an identification label (col. 4, lines 27-30) on substrates such as fabric, plastic, an article of clothing such as a shirt, or similar materials (equivalent to a personal item and cloth, col. 3, lines 25-28, col. 4, line 35). The printed image is applied to a designed label, ironed on a shirt for the purpose of identifying the child during an abduction (configured to be worn equivalency). See col. 1, lines 5-20 and lines 40-65, col. 2, line 3, lines 20-35 (instant claims 1-2, 4-7).

Floyd teaches the concept of providing printed pressure-distribution patterns, such as fingerprints, on items for identification purposes. However, Floyd does not teach an image having two-dimensional sampling of a pressure distribution pattern as claimed wherein

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differently colored and different shaded elements are present or samplings or peak or mean values obtained configured to identify shoes worn by a person (instant claims 1-2, 4-7).

Yamato teaches a two-dimensional distribution patterns printed in different colors obtained by walking by foot as claimed (Abstract, col. 3, lines 10-45, col. 4, lines 1-30). Thus, it would have been obvious to one having ordinary skill in the art to have modified the identification label of Floyd to add the two-dimensional printout image of Yamato because Floyd suggests attaching any printed image to a personal item and Yamato teaches a printed pattern printed illustrating walking patterns obtained via walking as claimed. (Abstract, col. 3, lines 35-50, col. 12, lines 32-65, col. 17, lines 20-25, and lines 60-65). Furthermore, pattern choice is a design choice, and given little weight. Thus, in combination, Applicant's invention is taught. Claim 1-2, 4-7 are addressed. That patterns are configured to identify a shoe to be worn is to intended use; it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Further to claims 1 and 7, that an image is obtained by sampling by walking or impressed by a thermotransfer process for reproducing patterns are process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be

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established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,454,600 to Floyd in view of USPN 6,345,839 to Kuboki et al.

Floyd teaches an infinite array of images may be contained in an identification label (col. 4, lines 27-30) on substrates such as fabric, plastic, an article of clothing such as a shirt, or similar materials (equivalent to a personal item and cloth, col. 3, lines 25-28, col. 4, line 35). The printed image is applied to a designed label, ironed on a shirt for the purpose of identifying the child during an abduction (configured to be worn equivalency). See col. 1, lines 5-20 and lines 40-65, col. 2, line 3, lines 20-35 (instant claims 13-17).

Floyd teaches the concept of providing printed pressure-distribution patterns, such as fingerprints, on items for identification purposes. However, Floyd does not teach an image having two-dimensional sampling of a pressure distribution pattern as claimed wherein differently colored and different shaded elements are present or samplings or peak or mean values obtained configured to identify pants worn by a person (instant claims 13-18).

Kuboki teaches a two-dimensional distribution patterns printed in different colors or shades obtained by sitting on a seat cushion where calculations of peak samplings are taken and printed as claimed (Abstract, shown in Figs. 21-27 and associated text, col. 5, lines 1-68, col. 7, lines 1-50, col. 15, lines 15-65).

Thus, it would have been obvious to one having ordinary skill in the art to have modified the identification label of Floyd to add the two-dimensional printout image pattern of Kuboki

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because Floyd suggests attaching any printed image to a personal item and Kuboki teaches a printed pattern printed illustrating patterns obtained via sitting on a seat cushion (Abstract, shown in Figs. 21-27 and associated text, col. 5, lines 1-68, col. 7, lines 1-50, col. 15, lines 15-65). Furthermore, pattern choice is a design choice, and given little weight. Thus, in combination, Applicant's invention is taught. Claim 13-17 are addressed. That patterns are configured to identify pants to be worn is to intended use; it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Further to claims 13 and 18, that an image is obtained by sampling by sitting or that an image is impressed by a thermotransfer process for reproducing patterns are process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Response to Arguments

Applicant's arguments filed 03-30-07 have been fully considered but they are not persuasive.

Applicant is reminded that he should also specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06. Applicant's statement arguing "support for which is provided in the specification", is not specific. Thus, the 112 rejection is applied as set forth above.

Applicant argues while Floyd teaches any printed image, it is not suggestion to combine with Yamato because Floyd states those printed images would include a fingerprint to disguise or camouflage the fingerprint while Yamato does not contain a fingerprint and nothing in Floyd suggests those images would include a two-dimensional pressure distribution pattern of Yamato. Applicant's argument is not convincing because while Applicant points to Floyd's use of printed images (such as the scenes described in the Abstract of Floyd) including fingerprints, Floyd still teaches many different illustrations or printed matter may be included on the face of the label (col. 3, lines 30-35), and doesn't necessarily limit the images to just fingerprints or to camouflage as Applicant argues. The suggestion for adding or substituting the image of Yamato comes from the primary teaching of Floyd, generally teaching images printed on labels for identification purposes. Fingerprints of Floyd are inherently pressure-distribution patterns, obtained by pressure from the force of a hand transferred to ink and paper. Footprints of Yamato are described as the same pressure-distribution pattern as that of the instant invention. Thus, Yamato was used to show a pressure distribution pattern as claimed is well known in the art and Floyd was used to show pressure distribution patterns are used in identification devices such as

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on a label and shirt. A footprint such as one taught by Yamato would camouflage well with the foot of the rabbit shown by Floyd, because both images are of a foot and Floyd shows a human print within the print of a rabbit's foot in FIG. 5. Substituting a human footprint such as disclosed by Yamato in place of the human fingerprint of Floyd would achieve the same result and overall purpose of identifying a person, as disclosed by Floyd. Therefore, when considered as a whole, the instant invention is taught. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Thus, when Applicant argues the images of Floyd inconspicuously conceal identification, while Yamato's two-dimensional pressure distribution pattern does not and is for measurement purposes, not used for purposes of personal identification is not convincing because Yamato is not relied upon to teach concealment, but the same pattern claimed by Applicant. The art is analogous because both are within the art of pressure distribution patterns. Furthermore, choosing a different pattern is a design choice, and given little weight. Also, an image of a pattern obtained by processes such as walking or sitting are process limitations and given little weight. A *prima facie* case has been established, and therefore the burden shifts to the Applicant to submit additional objective evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. Arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135,139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De*

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Blauwe, 736 F.2d 699,705, 222 USPQ 191, 196 (Fed. Cir. 1984). Until the Applicant has convincingly argued or has provided evidence to the contrary, the rejections are maintained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

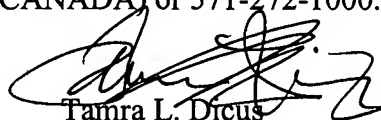
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tamra L. Dicus

Examiner

Art Unit 1774

May 30, 2007



RENA DYE

SUPERVISORY PATENT EXAMINER

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